

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

Claims 1, 2, 6-9, 11-13, 15-17, 20-32 and 34 were rejected under 35 U.S.C. Section 103(a) as allegedly being based on a proposed combination of Oki (U.S. Patent No. 5,859,969) and Nakagawa et al. (U.S. Patent No. 5,835,911). Claim 33 was rejected under 35 U.S.C. Section 103(a) as allegedly being made “obvious” by the proposed Oki-Nakagawa et al. combination, in further view of the admitted prior art described in the subject patent application.

The independent claims recite providing a program list which prioritizes programs that are likely to be operable in an operating environment of a user system. This feature finds support, for example, in the subject patent application at pages 38-41 of the subject patent application.

The office action acknowledges that Oki does not “explicitly show” the prioritized list of programs as claimed. See pages 5 and 13 of the office action. Nonetheless the office action maintains:

...the feature of prioritizing programs in a list is well known in the art and would have been an obvious modification of the system disclosed by Oki. One (sic) ordinary skill in the art at the (sic) of the invention would include (sic) the program list provided by host computer of Oki a mechanism to prioritize the programs in that list in such a way that most likely programs of interest are to the user are listed first. In this way it would be easier for the user to select the most appropriate programs first.

Applicant traverses this contention.

The office action asserts that it would have been obvious to prioritize Oki’s list such that “most likely programs of interest to the user are listed first.” However, the claims recite prioritizing programs that are likely to be operable in an operating environment of a user system. This is different than prioritizing based on user interest. Consequently, even assuming for the sake of argument that prioritizing based on user interest as alleged by the office action would have been obvious, modifying Oki in this manner would not result in the claimed subject matter, which involves prioritizing programs based on likely operability in a user system.

More specifically, according to Oki (see steps S1-19, especially col. 6, line 44 to col. 7, line 50), a user A selects a first keyword and a second keyword to ask host computer 21 for a list of software corresponding to both the first and second keywords. After the list of software is displayed on the screen of the display 24, the user A selects software from the list. Thus, the host computer 21 provides a list of software based on user inputs.

Consequently, according to Oki, the user must know what software he intends to update or install, and the software list corresponds to the user inputs. After the user selects software from the list, the host computer checks whether or not operation circumstances of the selected software match those of the user terminal 23.

In contrast, as described by way of example and without limitation in the subject patent application at pages 35-39, when a user wants to expand functions of an image forming apparatus 31, the user is not likely to know, for example, what exact function can be expanded. In this illustrative example, the image forming apparatus 31 only needs to request that the server 32 transmit a list of programs which can be supplied by the server 32, and there is no need for the user to select any specific software before the server 32 transmits a program list which prioritizes programs that are likely to be operable in an operating environment of the user system. Therefore, customer service can be improved. Neither Oki nor Nakagawa discloses or suggests the concept of a "program list which prioritizes programs that are likely to be operable in an operating environment of the user system" as variously set forth in each of the independent claims. Consequently, the proposed combination of Oki and Nakagawa would not have resulted in the subject matter of the pending claims.

NOMURA et al.
Appl. No. 09/892,747
Amendment Accompanying Request for Continued Examination

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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